REMARKS

Claims 1-22 remain pending in this patent application. No new matter has been added as a result of the Claim amendments.

Rejection under 35 U.S.C. § 102(e)

Claims 1, 3-6, 8, 10-13, 15-16 and 18-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hsieh et al., (2003/0093238) hereafter "Hsieh". Applicant has reviewed the cited reference and respectfully submits that Hsieh does not anticipate the present invention for the following rationale.

Applicant respectfully submits that Claim 1 (Claims 8 and 15 contain similar features) includes the feature "<u>when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems</u>" (emphasis added).

According to the Federal Circuit, "[a]nticipation requires the disclosure in a single prior art reference of each claim under consideration" (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)). However, it is not sufficient that the reference recite all the claimed elements. As stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention "arranged as in the claims" (Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)).

On page 6 at approximately lines 12-15, the Present Office Action states "[H]sieh et al. (USPUB 2003/0093238) <u>**does not appear to teach**</u> when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems" (emphasis added).

For this reason, Applicant respectfully states that Hsieh et al. does not anticipate each element of the claimed invention, much less, each element of the claimed invention

"arranged as in the claims". Specifically, Applicant respectfully submits, as the Office Action states, Hsieh does not appear to teach "when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems" as recited in Independent Claims 1, 8 and 15. As such, Applicant respectfully submits the rejection under 35 U.S.C. § 102(e) is overcome and that Independent Claims 1, 8 and 15 are in condition for allowance.

In addition, Applicant respectfully submits that Claims 3-6, 10-13, 16 and 18-21 are dependent on allowable Independent Claims 1, 8 and 15, and recite further features of the present claimed invention. Thus, Applicant respectfully submits that Claims 3-6, 10-13, 16 and 18-21 are also in condition for allowance.

<u>Rejection under 35 U.S.C. § 103(b)</u>

Claims 1-22 stand rejected under 35 U.S.C. § 103(b) as being obvious over Hsieh in view of Mathews (2003/0093238). Applicant has reviewed the cited reference and respectfully submits that the present invention is not rendered obvious over Hsieh in view of Mathews for the following rationale.

Applicant respectfully submits that Claim 1 (Claims 8 and 15 contain similar features) includes the feature "<u>when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems</u>" (emphasis added).

On pages 4 and 5 of the current Office Action, reference is made to Hsieh <u>alone</u> in supporting the grounds of rejection for Claims 1, 8 and 15. However, on page 6 at approximately lines 12-15, the Present Office Action states "[H]sieh et al. (USPUB 2003/0093238) **does not appear to teach** when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems" (emphasis added).

For this reason, Applicant respectfully states that the present rejection of Claims 1, 8 and 15 is improper as an essential element needed for a proper prima facie rejection is missing (e.g., the teaching of all of the recited claim features). As such, Applicant respectfully submits the rejection under 35 U.S.C. § 103(b) provided by the present Office Action is overcome and that Claims 1, 8 and 15 are in condition for allowance.

However, in the present Office Action, specifically the last two paragraphs of page 6 and the first paragraph of page 7, it appears as though an argument to combine the references of Hsieh in view of Mathews to overcome the shortcomings of Hsieh may have meant to be provided.

Applicant respectfully points out that even if this is the case, no actual argument regarding the combination of Hsieh in view of Mathews is actually ever made. Instead, a portion of Mathews is quoted without any context "[M]athews teaches when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems. (page 3 Paragraph 0020)(Fig3)"

Then, in addition to the out of context quote of Mathews, a further statement is made that "[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hsieh to automatically select and start an additional test case when any previous test case finishes taught by Knowles in order to reduce testing cycle times (Page 1, paragraph 0005, lines 14-17)."

Applicant respectfully submits that Knowles is not cited in the present Office Action and no further reference to Knowles is provided. As such, Applicant respectfully submits that the Office Action is not clear as to either the art being combined or the motivation for the combination in the present Office Action.

However, in the interest of expediting the prosecution of the application, Applicant has assumed that the "Knowles" reference was a clerical error and that the actual reference cited in the present motivation to combine argument section was meant to be "Mathews"; and has responded accordingly.

[T]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (MPEP 2143.03).

As the present Office Action clearly states, "Hsieh **does not appear to teach** when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems (emphasis added)" as claimed in independent Claim 1 and similarly recited in Claims 8 and 15.

In addition, Applicant submits that Mathews also fails to teach or suggest the shortcomings of Hsieh as relied upon in the present Office Action. Specifically, in the present Office Action, Mathews is relied upon to teach "when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems."

However, Claim 1 (and similarly Claims 8 and 15) clearly states; "A method of managing a testing task, said method comprising:

receiving a plurality of test cases to run, each test case including a plurality of requirements for running said respective test case;

receiving an identification of <u>a group of available test systems on which to run said test cases</u>;

for each test case, determining a list of applicable test systems from said group that satisfy said requirements of said respective test case;

<u>automatically selecting and starting test cases to run based on each respective list</u> and said available test systems so that as many test cases as possible are run in parallel;

<u>when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems</u>; and

providing the results of the testing task" (emphasis added).

Thus, Applicant points out that the claimed features are not "a <u>client system</u> capable of requesting a test instance any time the <u>client system is sitting idle</u>" as taught by Mathews.

In contrast, Claim 1 (and similarly Claims 8 and 15) is directed toward "receiving an identification of <u>a group of available test systems on which to run said test cases;</u>

for each test case, determining a list of applicable test systems from said group that satisfy said requirements of said respective test case; <u>automatically selecting and starting test cases to run based on each respective list</u> and said available test systems so that as many test cases as possible are run in parallel; <u>when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems</u>" (emphasis added).

In other words, the present invention automatically selects and starts test cases on available test systems; which is significantly distinct from the test system (or client system) requesting a test instance any time it is sitting idle.

For this additional reason, Applicant respectfully submits the rejection under 35 U.S.C. § 103(b) provided by the present Office Action is overcome and that Claims 1, 8 and 15 are in condition for allowance.

Further, with respect to the combination of Hsieh in view of Mathews as provided in the present Office Action, Applicant respectfully points out that [I]n order to establish a *prima facie* case of obviousness, the prior art <u>must</u> suggest the desirability of the claimed invention (MPEP 2142). In particular, "[i]t is improper to combine references where the references <u>teach away from</u> their combination" (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicant respectfully notes that "[a] prior art reference must be considered in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention" (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Applicant respectfully submits that there is no motivation to combine the teachings of

Hsieh in view of Mathews, because both Hsieh and Mathews teach away from the suggested modification.

Specifically, Applicant understands Hsieh et al. to teach the provision of testing files and associated data files to be centrally managed by a file server, so that they can be easily updated.

Moreover, Applicant understands Hsieh et al. to teach, in the first paragraph of the summary among other locations, a convenient and cost-effective testing procedure that can be completed in one pass at a single test site without having to undergo a number of test sites. Furthermore, Applicant respectfully understands Hsieh et al. to teach that the one pass testing steps are carried out automatically, but that the administrator forwards the test-procedure. This teaching by Hsieh et al. is directly opposite to the claimed feature "when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems."

Further, Applicant understands Hsieh to disclose performing a concurrent test procedure on a batch of computer products for quality assurance of the computer products before they are shipped to the market. [Hsieh; Abstract]. In Hsieh, once a quality assurance test is completed on a particular computer product, the particular computer product is shipped to the market instead of releasing the particular computer product to a group of available computer products on which additional tests from a plurality of tests are run.

Hsieh further discloses that "the testing procedure can be completed in one pass at a single test site; and that the one pass testing steps are carried out automatically, but that the administrator forwards the test-procedure", Hsieh teaches away from the claimed features of "when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems" (emphasis added).

As such, Applicant respectfully points out that Hsieh, in fact, teaches directly away from the claimed feature, "when any test case finishes running and releases a test system to said group of available test systems, <u>automatically selecting and starting an</u> <u>additional test case to run</u> if possible based on said respective list and said available test systems (emphasis added)" as claimed in independent Claim 1 and similarly recited in Claims 8 and 15.

As previously submitted, Applicant submits that Mathews also teaches away from the features as claimed. Applicant understands Mathews to teach a <u>client system</u> capable of requesting a test instance any time the <u>client system is sitting idle</u> as taught by Mathews.

In contrast, Claim 1 (and similarly Claims 8 and 15) is directed toward "receiving an identification of <u>a group of available test systems on which to run said test cases;</u>
for each test case, determining a list of applicable test systems from said group that satisfy said requirements of said respective test case; <u>automatically selecting and</u> <u>starting test cases to run based on each respective list</u> and said available test systems so that as many test cases as possible are run in parallel; <u>when any test case finishes running</u> <u>and releases a test system to said group of available test systems, automatically selecting</u> <u>and starting an additional test case to run if possible based on said respective list and said</u> <u>available test systems</u>" (emphasis added).

In other words, the present invention automatically selects and starts test cases on available test systems; which is significantly distinct from the test system (or client system) requesting a test instance any time it is sitting idle. As such, Applicant respectfully asserts that Mathews, in fact, teaches directly away from the claimed feature.

Thus, Applicant respectfully submits that there is no rational underpinning to support the legal conclusion of obviousness provided by the present Office Action. In fact, Applicant respectfully submits that both Hsieh and Mathews indicate distinctly different approaches for testing systems. Therefore, Applicant respectfully submits that the differences between the various system testing approaches would not have prompted a person of ordinary skill in the relevant field to combine the elements in the way the

instant Claims require. As such, Applicant respectfully submits that the present rejection rests on speculation and less than a preponderance of evidence and thus, fails to provide sufficient reasons for finding Claims 1, 8 and 15 unpatentable for obviousness under 35 U.S.C. § 103(a) over Hsieh in view of Mathews.

As such, Applicant respectfully submits that neither Hsieh nor Mathews, nor the combination thereof, show or suggest "when any test case finishes running and releases a test system to said group of available test systems, automatically selecting and starting an additional test case to run if possible based on said respective list and said available test systems" as recited in independent Claims 1, 8 and 15. Accordingly, Applicant respectfully submits that the basis for rejecting Claims 1, 8 and 15 under 35 U.S.C. § 103(a) is traversed.

In view of the combination of Hsieh in view of Mathews not showing or suggesting all of the limitations of independent Claims 1, 8 and 15, not satisfying the requirements of a *prima facie* case of obviousness, Applicants respectfully submit that independent Claims 1, 8 and 15 overcome the rejection under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance.

Applicants respectfully submit the combination of Hsieh in view of Mathews also does not teach or suggest the additional claimed features of the present invention as recited in Claims 2-7 that depend from independent Claim 1, Claims 9-14 that depend from independent Claim 8, and Claims 16- 22 that depend from independent Claim 15. Therefore, Applicants respectfully submit that Claims 2-7, 9-14 and 16-22 also overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance as being dependent on an allowable base claim.

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-22 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
Wagner Blecher LLP

Date: 9/20/07

John P. Wagner, Jr.
Reg. No. 35,398

WESTRIDGE BUSINESS PARK
123 WESTRIDGE DRIVE
WATSONVILLE, CALIFORNIA 95076
(408) 377-0500